



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,903	07/11/2000	Heather J. Jordan	0942.4450001	1446

26111 7590 11/20/2002

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W., SUITE 600
WASHINGTON, DC 20005-3934

EXAMINER

SISSON, BRADLEY L

ART UNIT PAPER NUMBER

1634

DATE MAILED: 11/20/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

C7ER

Office Action Summary

Application No.

09/613,903

Applicant(s)

JORDAN, HEATHER J.

Examiner

Bradley L. Sisson

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2002 and 09 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1634

DETAILED ACTION

Location of Application

1. The location of the subject application has changed. The subject application is now located in Workgroup 1630, Art Unit 1634.

Claim Objections

2. Claims 58 and 62 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 58 and 62 effectively broaden the scope of claim 43, from which the all depend, by requiring the bands not to be of the same relative intensity as is required in claim 43. .

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1634

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 43-56, 58-60 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Life Technologies Catalogue (1995-1996).

6. Life Technologies Catalogue discloses for sale a variety of DNA ladders. As seen at page 14-2, the ladder can be comprised of repeating units of 10 bp, and starting from an oligonucleotide of only 10 bp and can go to and beyond 100 bp. Also seen for sale are DNA ladders that are based on repeating units of 50 bp, 100 bp, 123 bp, 1 kb, etc.

7. Life Technologies Catalogue discloses that the concentration of some fragments in some ladders has been adjusted so that certain desired marker(s) appear brighter than others (a limitation of claim 58). It is also readily apparent that the individual bands in the 1 kb ladder also appear to be at the same relative intensity in the photo of a stained bands in a gel subsequent to electrophoresis (see page 14-4). As seen in the caption for thee 1 kb ladder, the DNA fragments can be visualized when stained with ethidium bromide (a limitation of claim 55).

8. It would have been obvious to one or ordinary skill in the art at the time the invention was made to have developed any of a variety of DNA ladders for use in an electrophoresis assay and to have adjusted the relative concentrations of the bands such that the intensities of any one or all bands was the same or more intense than others as the ordinary artisan desired. In view of

Art Unit: 1634

the well-developed state of the art, and the broad usage of such markers, the ordinary artisan would have been both highly motivated and would have had a most reasonable expectation of success.

9. Claims 57 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Life Technologies Catalogue 1995-1996 as applied to claim Claims 43-56, 58-60 and 62 above, and further in view of Lee (US patent 5,268,568).

10. See above for the basis of the rejection as it pertains to the disclosure of Life technologies Catalogue 1995-1996.

11. Life Technologies Catalogue 1995-1996 does not disclose the use of the dye mixture.

12. Lee discloses that just a dye mixture comprising bromophenol blue or xylene cyanol FF is routinely added to DNA samples to be subjected to electrophoresis.

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the DNA ladders of Life Technologies such that a dye comprising bromophenol blue was included given its common usage in electrophoresis of DNA samples.

14. In view of the commercial availability of DNA ladders, a kit comprising same would have been an obvious commercial expedient, requiring little, if any, additional effort on the part of the ordinary artisan.

Conclusion

15. In view of applicant having canceled all prior pending claims, all prior rejections of same have been rendered moot.

Art Unit: 1634

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. US Patent 5,840,575 (Hyman) discloses DNA ladders.
- b. US Patent 5,834,201 (Hartley) discloses DNA ladders.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

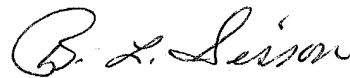
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (703) 308-3978. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the

Art Unit: 1634

organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

21. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Bradley L. Sisson
Primary Examiner
Art Unit 1634

BLS

November 18, 2002